UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,917	12/23/2004	Masato Yoshikawa	NEC03P070-SIb	7264

21254   7590   04/08/2008
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER
TAHA, SHAQ

ART UNIT	PAPER NUMBER
2146	

MAIL DATE	DELIVERY MODE
04/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 January 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 - 27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>12/23/2004</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This is a final action for application number 10/518,917 based on after non-final filed on

07/10/2007. The original application was filed on 12/2/2004. Claims 1 - 27 are currently

pending and have been considered below. Claims 1, 3 - 6, 8, 9, 11 - 14, 16, 17, 19 - 22,

and 24 are independent claims.

Response to Arguments

The applicant argues that Penny et al. (US 6,070,050) does not does not teach or

suggest means for appending to said message position information that indicates said

position that has been received as input, a position information transmission means for

transmitting position information that has been acquired by said position-acquisition

means to said server device, message management means for transmitting the

message to said terminal device that is the transmission destination when position

information that has been appended to said message matches with position information

from said terminal device that is the transmission destination that has been transmitted

in response to said position request.

The Examiner disagrees, Penny, Jr. et al. teaches Method and apparatus for delivering

messages to devices located within logical delivery areas. Penny Jr. et al further

teaches appending to said message position information that indicates said position that

has been received as input, [Fig. 2, Ref # R76 P260, wherein prefix P is identified as the position that has been received as input];

Penny Jr. further teaches a position information transmission means for transmitting position information, [Fig. 2, Ref # R76 P260 wherein the position P260 is the position information that is transmitted to server device by row 76 and position 260, also Fig. 1 shows satellite 110 which transmits position information to terminal 130];

Penny discloses a message management means for transmitting the message to said terminal device that is the transmission destination when position information that has been appended to said message matches with position information from said terminal device that is the transmission destination that has been transmitted in response to said position request, system 100 is a message management system that when control centers 117 receive requests to send messages from communication devices, the destination messaging device is desirably identified in the request by its messaging device identification number.

Claim Rejections - 35 USC § 101

In light of the applicants amendment to claims 17 – 24 the rejection under 35 USC 101 has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1 – 24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated

  by Penny, Jr. et al (US 6,070,050).

Regarding claim 1, 9, 17, Penny teaches a terminal device, **[Fig. 1, Ref # 130];**

comprising: means for receiving as input a destination of a message that is to be

transmitted, and a position at which the message is to be received, **[Fig. 2, Ref # R76**

P260]; and means for appending to said message position information that indicates

said position that has been received as input, **[Fig. 2, Ref # R76 P260 wherein prefix P**

is identified as the position that has been received as input in the message].

Regarding claim 2, 7, 10, 15, 18, Penny teaches a terminal device further comprising

position-acquisition means for acquiring the current position information, **[See Fig. 3,**

Ref # 320];

wherein said appending means appends to said message position information that has

been acquired by said position-acquisition means as position information of the position

at which the message is to be received, **[FIG. , Ref # R76 P260 wherein prefix P is identified as the position that has been received as input in the message].**

Regarding claim 3, 11, 19, 23, Penny teaches a terminal device comprising: position-acquisition means for receiving a position request from a server device and then acquiring a position, **[A request to deliver a message to a destination messaging device is received by a control center The destination messaging device is desirably identified in the request by its messaging device identification number, (Column 6, lines 1 – 5)].**

and a position information transmission means for transmitting position information that has been acquired by said position-acquisition means to said server device, **[Also in a preferred embodiment, the system calculates adjacent LDAs and/or beams within which to transmit a message in order to increase the likelihood that the destination messaging device will be able to receive the message, (Column 6, lines 14 – 17)].**

Regarding claim 4, 12, 20, Penny teaches a server device for delivering a message that has been transmitted from a terminal device that is a transmission origin to a terminal device that is the transmission destination, **[System 100 includes one or more control centers 117. Control centers 117 reside on the surface of the earth and are in communication with nearby satellite(s) 110 through link 119. Satellites 110 are**

also in communication with one another through cross-links 108, (Column 2, lines 23 – 27)];

said server device comprising: message storage means for, upon receiving a message that has been transmitted from a terminal device that is a transmission origin, storing the message that has been received, **[Processor 830 couples to memory 840, but may also include means for internal storing, (Column 7, lines 36 – 37)]**;

position request means for extracting destination address and position information from a message that has been stored in said message storage means, **[A request to deliver a message to a destination messaging device is received by a control center The destination messaging device is desirably identified in the request by its messaging device identification number, (Column 6, lines 1 – 5)]**.

and submitting a position request to the terminal device that is the transmission destination that is indicated by the destination address, **[When a request is received (704) to deliver a message to a messaging device (130), an Opportunity Table (600) is used to quickly determine which beam (210) to use to deliver the message, (See Abstract)]**;

and message management means for transmitting the message to said terminal device that is the transmission destination when position information that has been appended to said message matches with position information from said terminal device that is the transmission destination that has been transmitted in response to said position request, **[Also in a preferred embodiment, the system calculates adjacent LDAs and/or beams within which to transmit a message in order to increase the likelihood that**

the destination messaging device will be able to receive the message, (Column 6,

lines 14 – 17)].

Regarding claim 5, 21, Penny teaches a server device for delivering a message that has

been transmitted from a terminal device that is a transmission origin to a terminal device

that is a transmission destination, **[System 100 includes one or more control centers**

117. Control centers 117 reside on the surface of the earth and are in

communication with nearby satellite 110 through link 119. Satellites 110 are also

in communication with one another through cross-links 108, (Column 2, lines 23 –

27)];

the server device comprising: message storage means for storing messages,

[Processor 830 couples to memory 840, but may also include means for internal

storing, (Column 7, lines 36 – 37)];

 position request means for, upon receiving a message that has been transmitted from a

terminal device that is a transmission origin, submitting a position request to the

terminal device that is the transmission origin of the message that has been received,

and further, **[When a request is received (704) to deliver a message to a messaging**

device (130), an Opportunity Table (600) is used to quickly determine which beam

(210) to use to deliver the message, (See Abstract)];

extracting a destination address and position information from a message that is stored

in said message storage means, **[In a preferred embodiment, the location is**

established using the LDA coordinate system of rows and positions and/or

associated LDA number, (Column 6, lines 9 – 11)];

and submitting a position request to the terminal device that is the transmission

destination of the destination address, **[When a request is received (704) to deliver a**

message to a messaging device (130), an Opportunity Table (600) is used to

quickly determine which beam (210) to use to deliver the message, (See

Abstract)];

appending means for appending position information of said terminal device that is the

transmission origin that has been transmitted in response to a position request to said

terminal device of the transmission origin to said message as position information of the

position at which the message is to be received, **[FIG. 2 indicates that, to determine**

LDAs adjacent to LDA 204, one only needs to add or subtract one to a row

number and add or subtract one from the position number, (Column 6, lines 21 -

25)];

and storing in said message storage means, **[Processor 830 couples to memory 840,**

but may also include means for internal storing, (Column 7, lines 36 – 37)];

and message management means for transmitting the message to said terminal device

that is the transmission destination when position information of said terminal device

that is the transmission destination and that has been transmitted in response to a

position request to said terminal device that is the transmission destination matches

with position information that has been appended to said message, **[Also in a**

preferred embodiment, the system calculates adjacent LDAs and/or beams within

which to transmit a message in order to increase the likelihood that the

destination messaging device will be able to receive the message, (Column 6,

lines 14 – 17)].

Regarding claim 6, 13, Penny teaches a message transmitting and receiving system for

delivering a message that has been transmitted from a terminal device that is a

transmission origin to a terminal device that is a transmission destination, **[A global**

message delivery system (100) transmits messages to messaging devices (130)

using a plurality of satellites, (See Abstract)];

said message transmitting and receiving system comprising: a terminal device, **[A**

global message delivery system transmits messages to messaging devices, (See

Abstract)];

that is the transmission origin that includes: means for receiving as input the destination

of a message and the position at which the message is to be received, , **[In a preferred**

embodiment, the location is established using the LDA coordinate system of

rows and positions and/or associated LDA number, (Column 6, lines 9 – 11)];

and appending means for appending to said message position information that indicates

said position that has been received as input, **[FIG. 2 indicates that, to determine**

LDAs adjacent to LDA 204, one only needs to add or subtract one to a row

number and add or subtract one from the position number, (Column 6, lines 21 -

25)];

a server device, **[System 100 includes one or more control centers 117. Control centers 117 reside on the surface of the earth and are in communication with nearby satellite 110 through link 119. Satellites 110 are also in communication with one another through cross-links 108, (Column 2, lines 23 – 27)]**;

that includes: message storage means for, upon receiving a message that has been transmitted from said terminal device that is the transmission origin, storing the message that has been received, **[Processor 830 couples to memory 840, but may also include means for internal storing, (Column 7, lines 36 – 37)]**;

position request means for extracting a destination address and position information from a message that has been stored in said message storage means and submitting a position request to a terminal device that is the transmission destination that is indicated by said destination address, **[A request to deliver a message to a destination messaging device is received by a control center The destination messaging device is desirably identified in the request by its messaging device identification number, (Column 6, lines 1 – 5)]**;

and message management means for transmitting said message to said terminal device that is the transmission destination when position information that has been appended to said message matches with position information from said terminal device that is the transmission destination that has been transmitted in response to said request for position, **[Also in a preferred embodiment, the system calculates adjacent LDAs and/or beams within which to transmit a message in order to increase the**

likelihood that the destination messaging device will be able to receive the

message, (Column 6, lines 14 – 17)];

and a terminal device that is the transmission destination that includes: first position-

acquisition means for receiving a position request from said server device and acquiring

position, **[A global message delivery system transmits messages to messaging**

devices, (See Abstract)];

and position information transmission means for transmitting position information that

has been acquired by said first position-acquisition means to said server device, **[Also**

in a preferred embodiment, the system calculates adjacent LDAs and/or beams

within which to transmit a message in order to increase the likelihood that the

destination messaging device will be able to receive the message, (Column 6,

lines 14 – 17)].

Regarding claim 8, 14, 22, Penny teaches a message transmitting and receiving system

for transmitting a message that has been transmitted from a terminal device that is a

transmission origin to a terminal device that is a transmission destination, **[A global**

message delivery system (100) transmits messages to messaging devices (130)

using a plurality of satellites, (See Abstract)];

said message transmitting and receiving system comprising: a terminal device that is

the transmission origin that includes: first position-acquisition means for receiving a

position request from said server device and acquiring position, , **[A global message**

delivery system transmits messages to messaging devices, (See Abstract)];

and position information transmission means for transmitting position information that

has been acquired by said first position-acquisition means to said server device, **[Also**

in a preferred embodiment, the system calculates adjacent LDAs and/or beams

within which to transmit a message in order to increase the likelihood that the

destination messaging device will be able to receive the message, (Column 6,

lines 14 – 17)];

a server device, **[System 100 includes one or more control centers 117. Control**

centers 117 reside on the surface of the earth and are in communication with

nearby satellite 110 through link 119. Satellites 110 are also in communication

with one another through cross-links 108, (Column 2, lines 23 – 27)];

that includes: message storage means for storing messages, **[Processor 830 couples**

to memory 840, but may also include means for internal storing, (Column 7, lines

36 – 37)];

position request means for, upon receiving a message that has been transmitted from a

transmission origin terminal device, **[A request to deliver a message to a destination**

messaging device is received by a control center The destination messaging

device is desirably identified in the request by its messaging device identification

number, (Column 6, lines 1 – 5)];

submitting a position request to the terminal device that is the transmission origin of the

message that has been received, **[When a request is received (704) to deliver a**

message to a messaging device (130), an Opportunity Table (600) is used to

quickly determine which beam (210) to use to deliver the message, (See

Abstract)];

and further, extracting the destination address and position information from a message

that has been stored in said message storage means and submitting a position request

to the transmission destination terminal device of the destination address, **[In a**

preferred embodiment, the location is established using the LDA coordinate

system of rows and positions and/or associated LDA number, (Column 6, lines 9

– 11)];

appending means for appending to said message position information of said terminal

device that is the transmission origin that has been transmitted in response to the

position request to said terminal device that is the transmission origin as position

information of the position at which the message is to be received, **[FIG. 2 indicates**

that, to determine LDAs adjacent to LDA 204, one only needs to add or subtract

one to a row number and add or subtract one from the position number, (Column

6, lines 21 - 25)];

and storing in said message storage means, **[Processor 830 couples to memory 840,**

but may also include means for internal storing, (Column 7, lines 36 – 37)];

and storing the message in said message storage means, **[Processor 830 couples to**

memory 840, but may also include means for internal storing, (Column 7, lines 36

– 37)];

and message management means for transmitting the message to said terminal device

that is the transmission destination when position information that has been appended

to said message matches with position information of said terminal device that is the

transmission destination that has been transmitted in response to the position request to

said terminal device that is the transmission destination, **[Also in a preferred**

embodiment, the system calculates adjacent LDAs and/or beams within which to

transmit a message in order to increase the likelihood that the destination

messaging device will be able to receive the message, (Column 6, lines 14 – 17)].

and a terminal device that is the transmission destination, **[A global message delivery**

system transmits messages to messaging devices, (See Abstract)];

that includes: second position-acquisition means for accepting a position request from

said server device and then acquiring position; and position information transmission

means for transmitting position information that has been acquired by said second

position-acquisition means to said server device, **[In a preferred embodiment, the**

location is established using the LDA coordinate system of rows and positions

and/or associated LDA number, (Column 6, lines 9 – 11)];

Regarding claim 16, 24, Penny teaches a message transmitting and receiving method

for delivering a message that has been transmitted from a terminal device to a terminal

device that is a transmission destination, **[A global message delivery system (100)**

transmits messages to messaging devices (130) using a plurality of satellites,

(See Abstract)];

said message transmitting and receiving method comprising: in a server device, upon

receiving a message that has been transmitted from a terminal device that is the

transmission origin, submitting a position request to the terminal device that is the

transmission origin that has transmitted the message that has been received, **[When a**

request is received (704) to deliver a message to a messaging device (130), an

Opportunity Table (600) is used to quickly determine which beam (210) to use to

deliver the message, (See Abstract)];

in said terminal device that is the transmission origin receiving the position request from

said server device and acquiring its position, **[When a request is received (704) to**

deliver a message to a messaging device (130), an Opportunity Table (600) is

used to quickly determine which beam (210) to use to deliver the message, (See

Abstract)];

in said server device appending the position information of said terminal device that is

the transmission origin that has been transmitted in response to the position request to

said terminal device that is the transmission origin to said transmission message as

position information of the position at which the message is to be received and storing

the message, **[In step 704, a request to deliver a message to a destination**

messaging device is received by a control center The destination messaging

device is desirably identified in the request by its messaging device identification

number, (Column 6, lines 1 – 5)];

in said server device extracting a destination address and position information from the

message that has been stored, **[A request to deliver a message to a destination**

messaging device is received by a control center The destination messaging

device is desirably identified in the request by its messaging device identification number, (Column 6, lines 1 – 5)];

and submitting a position request to the transmission destination terminal device of the destination address, **[When a request is received (704) to deliver a message to a messaging device (130), an Opportunity Table (600) is used to quickly determine which beam (210) to use to deliver the message, (See Abstract)];**

the terminal device that is the transmission destination, receiving the position request from the server device and acquiring position, **[A request to deliver a message to a destination messaging device is received by a control center The destination messaging device is desirably identified in the request by its messaging device identification number, (Column 6, lines 1 – 5)];**

in said terminal device that is the transmission destination transmitting said position information that has been acquired to said server device, **[A global message delivery system transmits messages to messaging devices, (See Abstract)];**

in said server device, transmitting the transmission message to said transmission destination terminal device when position information that is appended to said transmission message matches with position information from said transmission destination terminal device that has been transmitted in response to said position request, **[In step 704, a request to deliver a message to a destination messaging device is received by a control center The destination messaging device is desirably identified in the request by its messaging device identification number, (Column 6, lines 1 – 5)].**

Regarding claim 27, Penny Jr. et al. teaches the method, wherein after said terminal device that is the transmission destination transmits the acquired position information to said server device, said server device periodically submits a position request to said terminal device that is the transmission destination, **[Fig. 7, step 704, a request to deliver a message to a destination messaging device is received by a control center The destination messaging device is desirably identified in the request by its messaging device identification number].**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

- Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penny Jr. et al. (US 6,070,050) in view of Lau et al. (US 7,321,774).

Regarding claim 25 and 26, Penny Jr. et teaches Method and apparatus for delivering messages to devices located within logical delivery areas;

Penny Jr. et al differs from the claimed invention is that an instant message, e-mail, and GPS is not taught by Penny Jr. et al.

Lau et al. teaches position sensing devices that allow widespread use and availability of

position information;

Lau et al further teaches that said message comprises one of an electronic mail

message and an instant message, **[The transmission of information from/to the**

position-sensing device can also be in a text message format, e.g. e-mail or

instant message,(Column 18, line 56)];

Lau et al. also teaches that said first position-acquisition means comprises a global

position system (GPS) unit, **[Fig. 12A, Ref # GPS baseband processor];**

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify Penny Jr. et al by including an instant message, e-mail and GPS

as taught by Lau et al.

One of ordinary skill in the art would have been motivated to make this modification in

order provide the advantage of providing that said message comprises one of an

electronic mail message and an instant message, and that said first position-acquisition

means comprises a global position system (GPS) unit.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to **Shaq Taha** whose telephone number is 571-270-1921.

The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Jeff Pwu** can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Shaq Taha

03/31/2008

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2146